

### REMARKS

This responds to the Office Action mailed on February 1, 2006.

Claims 25, 26, and 29 are amended, claims 28, 35 - 44 are canceled, and claims 45 – 55 are added; as a result, claims 25 – 27, 29 – 34, and 45 – 55 are now pending in this application.

No new matter has been added. The amendments are made to clarify the claims and are not intended to limit the scope of equivalents to which any claim element may be entitled. The amendments and the new claims are fully supported throughout the specification as originally filed. For example, some of the amendments to independent claim 25 and new independent claim 46 are supported by Figure 8 and its corresponding description (see in particular, block 841 and block 843 of Figure 8).

Claims 35 – 44 were previously withdrawn in response to a restriction requirement and now have been cancelled. Applicant specifically reserves the right to file divisional applications at a later date to reintroduce claims 35 – 44.

The elements of new claims 45 – 55 correspond to the elements of method claims 25 – 27 and 29 – 34; the new claims 45 – 55 are merely rewritten in the form of computer readable medium claims.

Applicant respectfully requests reconsideration and allowance of the above-identified application in view of the amendments above and the remarks that follow.

### Interview Summary

Applicant thanks Mary D. Cheung for generously granting telephone interviews on April 12<sup>th</sup>, June 27<sup>th</sup>, and June 30<sup>th</sup> with Applicant's representative Ann McCrackin. During each telephone call, claim 25 was discussed in view of the Provost reference. After the June 30<sup>th</sup> telephone interview, the Applicant agreed to submit the amendments to claim 25 included with this response.

Double Patenting Rejection

Claims 25-34 were rejected under the judicially created doctrine of double patenting over claims 1-26 of U.S. Patent No. 5,889,941.

Claims 25-34 were also rejected under the judicially created doctrine of double patenting over claims 1-13 of U.S. Patent No. 6,014,748.

Applicant will submit a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) to obviate these rejections after the claims are otherwise indicated as allowable.

§102 Rejection of the Claims

Claims 25-34 were rejected under 35 U.S.C. § 102(e) for anticipation by Provost (U.S. 6,335,799). Applicant respectfully submits that the claims as amended are distinguishable over Provost for the reasons stated in the previous response and the additional reasons outlined below.

The claims of the present application are directed to personalizing portable programmed data carriers. The elements of independent claim 25 recite a method of processing data for portable programmed data carriers. The term “portable programmed data carriers” appears in multiple places within claim 25. Portable programmed data carriers are described as follows in the specification:

“Increasing numbers of organizations which issue transaction cards to their users, customers, or employees require cards tailored to meet the requirements of their particular service or application. These organizations also want the cards to contain data about the cardholder. Existing transaction cards encode such data in a magnetic stripe on the back of the card but the amount of data that can be held by a magnetic stripe is limited. A new type of transaction card embeds a microprocessor computer chip in the plastic of the card to greatly increase the card's data storage capacity. Additionally, sophisticated card applications specific to the card issuer can execute in certain varieties of the chips, and the chip may also contain a type of operating system. Transaction cards with embedded chips are referred to in the industry as portable programmed data carriers, more commonly called "smart cards."” (See Applicant's Specification, Page 1, Lines 13 – 23) (Emphasis Added)

In contrast, Provost is directed to a system that uses ink to print information on an exterior writing surface of a plastic card that has been specifically prepared for printing. The system described by Provost utilizes an “. . . ink delivery system and a prepared card writing

surface to efficiently produce personalized cards.” (See Provost, Col. 4, Lines 9 – 11) The system in Provost is further described as follows:

“The card personalizer system consists of three essential components: a computer for data entry and driving a printing system, a printing system, and a modified plastic card. The computer allows entry of unique card identification numbers and client personal information. This information is then correlated and stored. The second function performed by the computer is the driving of a printing system that is capable of printing on portions of plastic cards which have been specially prepared for printing. Industry standard plastic cards that have been modified by the addition of a prepared writing surface are used in the preferred embodiment.” (See Provost, Col. 3, Lines 52 – 62) (Emphasis Added)

Applicant can find no teaching in Provost of processing data for “portable programmed data carriers” as recited in pending claims 25 – 27, 29 – 34, and 45 – 55. For example, independent claim 25 recites elements of a method for processing data for one or more individual cardholders in a first batch of portable programmed data carriers including the following elements:

*acquiring personalization data for a cardholder in a first batch of portable programmed data carriers;*

*acquiring personalization equipment characteristics for a particular type of personalization equipment to issue the portable programmed data carriers for the first batch;*

*creating instructions for an internal script from the personalization data; and*  
*translating the internal script into programming control commands for the particular type of personalization equipment in accordance with the personalization equipment characteristics. . .*

The method recited in independent claim 25 also determines if data is to be processed for a subsequent batch of portable programmed data carriers and recites the following elements:

*. . . if the first batch includes additional cardholders, then for each one of the additional cardholders in the first batch, repeating the actions of acquiring personalization data, creating instructions for the internal script, and translating the internal script; and*

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*determining if further data is to be processed for a subsequent batch of portable programmed data carriers, and if further data is to be processed for the subsequent batch, then acquiring personalization equipment characteristics for one of a plurality of types of personalization equipment to issue the subsequent batch;*

*wherein the subsequent batch is different than the first batch.*

As noted above, amended claim 25 also recites that the subsequent batch of portable programmed data carriers is different than the first batch of portable programmed data carriers.

Claims 26 – 27 and 29 – 34 depend, directly or indirectly, on claim 25 and are patentable over Provost for the reasons outlined above, and are also patentable in view of the additional elements in the claims. Likewise, the elements of new claims 45 – 55 correspond to the elements of method claims 25 – 27 and 29 – 34 and are patentable over Provost for the reasons outlined above.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9592 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1st day of August, 2006.

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